Asia Domain Name Dispute Resolution Centre
(Hong Kong Office)

Uniform Domain Name Dispute Resolution Policy

Panelist Decision

Case No. HK-1300526

Complainant: **PAUL SMITH GROUP HOLDINGS LIMITED**

Respondent: **WENZHUO CHEN**

Contested Domain Name: **paulsmithensoldes.com**

Registrar: **HICHINA ZHICHENG TECHNOLOGY LTD**

Panel Member: **Christopher To**

---

1. Parties and Contested Domain Name

The Complainant is **Paul Smith Group Holdings Limited** of The Poplars, Lenton Lane, Nottingham, NG7 2PW, Great Britain.

The Respondent is **Wenzhuo Chen** of Beijing Zhongqingshi, Jiulongpoqu, Huangjuepingjie 108hao, 400053, China.

The contested domain name is "paulsmithensoldes.com" ("***Disputed Domain Name***").

The Registrar of the Disputed Domain Name is HICHINA ZHICHENG TECHNOLOGY LTD ("***Registrar***") of 3/F HiChina Mansion27 Gulouwai Avenue, Dongcheng District, Beijing, 100120, China.

2. Procedural History

On 9 July 2013, pursuant to the Internet Corporation For Assigned Names and Numbers Uniform Domain Name Dispute Resolution Policy ("***ICANN Policy***"), the Internet Corporation For Assigned Names and Numbers Rules for the Uniform Domain Name Dispute Resolution Policy ("***ICANN Rules***") and the Asian Domain Dispute Resolution Centre Supplemental Rules for Uniform Domain Name Dispute Resolution Policy ("***ADNDRC Supplemental Rules***"), the Complainant filed a Complaint in this matter with the Hong Kong Office of the Asian Domain Dispute Resolution Centre ("***ADNDRC-HK***").

On 10 July 2013, the ADNDRC-HK notified HICHINA ZHICHENG TECHNOLOGY LTD at <zhaoyang@hichina.com> and <disputes@hichina.com>, the Registrar of the Disputed Domain Name of the proceedings by email.

On 11 July 2013, the Registrar acknowledged the email of ADNDR-HK confirming that the Disputed Domain Name is registered, that Wenzhuo Chen is the holder of the Disputed Domain Name. As a result, the Internet Corporation For Assigned Names and Numbers Rules for the Uniform Domain Name Dispute Resolution Policy ("***ICANN Rules***") is applicable to the Disputed Domain Name, the language of the Registration Agreement of the Disputed Domain Name is in the Chinese language as provided by the Registrar (See: http://www.net.cn). At the time of writing this decision, the Disputed Domain Name website is still in operation (See: http://www.paulsmithendoes.com).

On 15 July 2013, the ADNDR-HK confirmed the receipt of the Complaint submitted on 9 July 2013. In the meantime, the ADNDRC-HK notified the Complainant that the language of registration agreement of the Disputed Domain Name is Chinese. In accordance with the Uniform Domain Name Dispute Resolution Policy ("***ICANN Rules***"), Paragraph 11(a) stated as follow:

> "*1. Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement,* ***the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding****.*
>
> *2. The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.*"

In the meantime, the ADNDRC-HK informed the Complainant that the name of the Respondent should be "wenzhuo chen" rather than "wenzhou chen". Subsequently, the ADNDRC-HK noted that:

> "*On this basis, could you please submit the amended Complaint Form together with the Chinese translation to us and serve a copy to the concerned Registrar (zhaoyang@hichina.com) and the Respondent on or before* ***20 Jul 2013****.*
>
> *Alternatively, if you request that English be used as the language of the administrative proceeding and wish to refer the language issue to be decided by the Panelist, please let us know and provide us of your request by above deadline.*"

On 22 July 2013, the ADNDRC-HK notified the Complainant that it did not receive the revised Complaint within the stipulated timeframe. The ADNDRC-HK referred to Paragraph 4(b) of the ICANN Rules, stated as follows:

> "*If the Provider finds the complaint to be administratively deficient, it shall promptly notify the Complainant and the Respondent of the nature of the deficiencies identified. The Complainant shall have five (5) calendar days within which to correct any such deficiencies, after which the administrative proceeding will be deemed withdrawn without prejudice to submission of a different complaint by Complainant.*"

From this, the ADNDRC-HK stated that:

> "*According to Article 4(b) of the Rules of UDRP, the captioned complaint is deemed to be withdrawn and administrative proceeding is terminated. However,* ***a new complaint concerning the same Domain Name can still be re-filed without any impact to it***"

On 23 July 2013, the Complainant sent the revised Complaint ("the Complaint"), together with supporting evidence as well as documents to the ADNDRC-HK. In addition, the Complainant requested the Panel to adopt English as the language of the administrative proceedings, and stated that:

> "*The reasons for this request are as follows: there would be an* ***additional cost to the Complainant to translate*** *this Complaint and this would be inequitable given the damage that has been suffered to date in this matter by the operation of the infringing website. Further, it is* ***unnecessary to incur such cost since we have written to the Registrar on several occasions****, we have called and we know that the Registrar can conduct these proceedings in English. Furthermore, the Registrar has been* ***given numerous opportunities to assist us*** *in taking action against the infringing website but has, to date,* ***not acknowledged our emails and telephone calls***."

On 23 July 2013, the ADNDRC-HK confirmed receipt of the Complaint as well as the case filing fee.

On 23 July 2013, the ADNDRC-HK notified the Complainant that the Case Number of the contested Dispute changed from "HK-1500516" to "HK-1500526".

On 23 July 2013, the ADNDRC-HK sent a Notification of Commencement of Proceeding in English and Chinese ("***Notification***"), together with the Complaint, to the email address of the Respondent's nominated registrant contact for the Disputed Domain Name, (As recorded in the WHOIS database, the Respondent's email address is <wmnaie@163.com>). The Notification gave the Respondent twenty (20) calendar days to file a Response (i.e. on or before 12 August 2013).

On 24 July 2013, the ADNDR-HK sent the Notification by fax unsuccessfully with "NO ANSWER" (See: TX RESULT REPORT stated that the "RESULT" was "NO ANSWER"). Subsequently, the ADNDRC-HK made a further attempt by posting the Complaint, together with supporting evidence as well as documents to the Respondent to the following address:

"*Beijing Zhongqingshi,*
Jiulongpoqu,
Huangjuepingjie 108hao,
400053,
Wenzhuo Chen"

On 13 August 2013, the ADNDRC-HK through an email informed the Complainant that the Respondent had not responded to the ADNDRC-HK within the stipulated timeframe (i.e. on or before 12 August 2013). As such the Respondent has not contested the allegations of the Complainant and is in default.

The Panel comprising Mr. Christopher To as a single panelist was appointed by the ADNDRC-HK on 21 August 2013. The documents pertaining to the case were delivered to the Panel by email on 21 August 2013, followed by a hard copy on 26 August 2013.

In accordance with Paragraph 15(a) of the ICANN Rules, the Panel is of the view that it shall decide the Complaint on the basis of the statements and documents submitted.

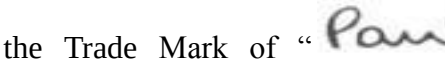
Also, according to Paragraph 15(d) of the ICANN Rules, this Panel shall issue a reasoned decision.

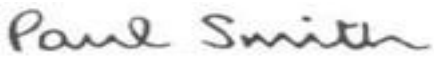
3. Factual Background

For the Complainant

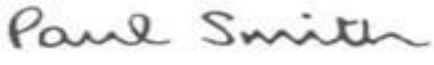
Paul Smith Group Holdings Limited and its subsidiary, namely, the Paul Smith Limited registered the Trade Mark of "Paul Smith" since 16 February 1983 (See: United Kingdom trademark registration number

UK00001190572). The "  " is a brand recognised internationally for design, fashion clothing as well as accessories.

Throughout the years, the Trade Mark of "  " developed a significant reputation as a designer both in the United Kingdom and abroad. In particular, the brand managed to reached the top end of the retail market producing high quality products by using the finest raw material and innovative techniques. In addition, the Trade Mark of "Paul Smith" has been used by the Complainant extensively for marketing purposes throughout the world.

In relation to the trademarks registration, the Complaint is the owner of the United Kingdom trademark registration number UK00001190572 with an actual date of registration of 16 February 1983. The Trade Mark relates to a mark made up of letters "  " The Trade Mark is currently registered in Class 25:

> *Class 25: Scarves, shoes, vests, boxer shorts, jackets, trousers, knitted articles of clothing, articles of clothing made from knitted materials, waistcoats, shirts, suits and coats; belts, ties, socks and gloves; all being articles of clothing; all for men*

The Complaint is also the owner of the United Kingdom trademark registration number UK00002051161 with an actual date of registration of 16 May 1997. The Trade Mark relates to a mark made up of letters "PAUL SMITH" and "  ". The Trade Mark is currently registered in Class 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34:

> *Class 3: Perfumery, colognes; cosmetics; soaps; shampoo, preparations for use for and after shaving, toilet preparations, skin care and hair care preparations, deodorants, anti-perspirants, dentifrices, bath and shower preparations; talcum powder; show cleaning preparations*

Class 8: Hand tools and implements (hand operated); cutlery; side arms; razors; knives, penknives; tweezers; manicure sets, pedicure sets, nail clippers, nail files; razor blades, razor cases; scissors; shaving cases.
Class 9: Spectacle frames, sunglasses frames, sunglasses, lenses, clips, cases and containers for spectacles and sunglasses, radios, calculators, parts and accessories for all the aforesaid goods;

Class 14: Precious metals and their alloys and goods inprecious metals or coated therewith, not included in other Classes, jewellery, precious stones, horological and chronometric instructments, imitation jewellery, brooches, cuff-links, ornamental pins, tie pins, watches, watch straps, clocks, money clips, key rings.

Class 16: Paper; cardboard and cardboard articles; stationery, printed matter, printed publications, calendars, albums, writing materials and writing implements, notebooks, note pads, diaries, address books, posters, loose-leaf binders, files, folders; pen and pencil sets, cases and standards; letter racks, paper knives, cards, playing cards, paperweights, parts and fittings for all the aforesaid goods.

Class 18: Leather and imitations of leather; and goods made of these materials not included in other Classes; animals skins; hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; luggage; rucksacks, bags, briefcases, pocket wallets, purses, pouches, credit card holders, chewing gum holders, notebook holders, coin holders, key cases.

Class 21: Soap boxes, hair brushes, combs, comb cases, brushes for footwear, nail brushes, shaving brushes, shaving brush stands, toothbrushes, clothes brushes, toilet, shoe horns, shoe trees, household and kitchen utensils and containers.

Class 24: Textiles and textile goods, not included in other Classes; bed and table covers; blankets, rugs, towels, face flannels, handkerchiefs.

Class 25: Articles of clothing, footwear, headgear; gloves, scarves, shawls, belts, braces, ties.

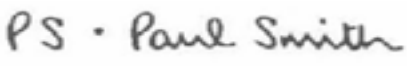
Class 34: Tobacco; smoker's articles; matches; lighters, cigarette cases, cigar cases.

The Complainant is also the owner of the United Kingdom trademark registration number UK00002184370 with an actual registration date of 4 June 1999. The Trade Mark relates to a mark made up of letters "PS · Paul Smith". The Trade Mark is currently registered in Class 25.

Additionally, the Complainant is the owner of the WIPO trademark registration number 0000755406 with an actual registration date of 20 March 2001. The Trade Mark relates to a mark made up of letters "PAUL SMITH" and has been granted protection in many countries including the United Kingdom, China, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro. The Trade Mark is currently registered in Class 03, 09, 14, 16, 18 and 25.

Likewise, the Complainant is also the owner of the WIPO trademark registration number 0000988039 with an actual registration date of 5 June 2008. The Trade Mark relates to mark made up of letters "Paul Smith" and has acquired protection in many countries including the United Kingdom and Bahrain. The Trade Mark is currently registered in Class 03, 09, 14, 16, 18 and 25.

The Complainant is also an owner of the WIPO trademark registration number 0000708450 with an actual registration date of 11 February 1999. The Trade Mark relates to a mark make up of letters "PS · Paul Smith" and has acquired protection in many countries including the United Kingdom, China, Benelux, Switzerland, Czech Republic, Germany, Denmark, Finland, France, Hungary, Iceland, South Korea, Monaco, Norway, Poland, Portugual, Romania, Sweden, Turkey and Serbia and Montenegro. The Trade Mark is currently registered in Class 25.

As a result, the Complainant is of the view that the registered trademarks, namely, "PAUL SMITH", "  " and "  " have substantiated a worldwide reputation and have been used by the Complainant extensively for marketing purposes throughout the world.

On 5 July 2013, the Complainant filed the Complaint to the ADNDRC-HK, asserted that, "*Using WWW.GOOGLE.COM the Complainant searched for 'PAUL SMITH' and obtained 512,000,000 results. Using WWW.GOOLE.COM.HK the Complainant searched for 'PAUL SMITH' and obtained 31,100,000 results. The information* ***on the first page of the search result is associated to the Complainant***".

For the Respondent

The Respondent, Wenzhuo Chen, is an individual who resides in the People's Republic of China.

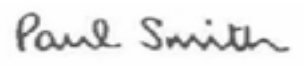
On 8 November 2012, the Disputed Domain Name "paulsmithensoldes.com" was registered by HICHINA ZHICHENG TECHNOLOGY LTD, and the holder of the Disputed Domain Name, as noted by the Registrar's email of 11 July 2013, was Wenzhuo Chen.

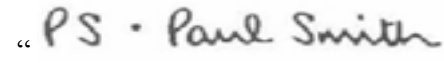
On 13 August 2013, the ADNDRC-HK through an email informed the Complainant that the Respondent has not responded to the ADNDRC-HK within the stipulated timeframe (i.e. on or before 12 August 2013). As such the Respondent has not contested the allegations of the Complainant and is in default.

4. Parties' Contentions

The Complainant

The Complainant submits that its Group companies is the registered proprietor of the

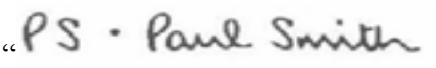
trademarks of "PAUL SMITH", "  " and "  ".

The Complainant further submits that the Disputed Domain Name would easily be interpreted as "*'paulsmith' + 'en' + soldes*". The Complainant drew to the Panel's attention that the word "en" and "soldes" are general French words meaning "in" and "sale". Thus, the Complainant was of the opinion that the Disputed Domain Name can easily be understood as "***the French sale website for PAUL SMITH goods***". The Complainant advocates that the Complainant's trademarks, namely, "PAUL SMITH", "  " and "  ", are **central and distinguishable element of the Disputed Domain Name**.

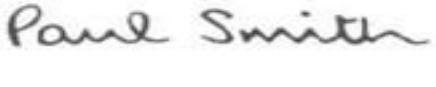
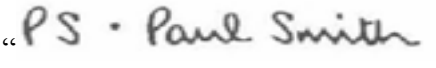
The Complaint submits that the Disputed Domain Name website **was selling fake counterfeit PAUL SMITH products in large quantities**. From this, the Complainant contends that this serves as good evidence proving that the Respondent was trying to use the Disputed Domain Name website as "the French sale website for PAUL SMITH goods".

Furthermore, the Complaint drew to the Panel's attention that images and models used on the Disputed Domain Name website are in fact, virtually and substantially similar to those used by the Complainant's trademarks, namely, "PAUL SMITH", "  " and "". On this basis, the Complainant was of the view that the Respondent is promoting this website as the official Paul Smith French sale website for goods.

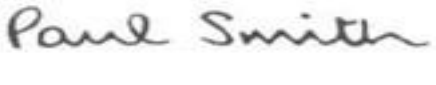
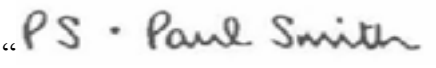
For the foregoing reasons, the Complainant submits that the Disputed Domain Name can easily **mislead consumers to mistakenly believe the Disputed Domain Name is owned or operated by the Complainant, or the Respondent has certain relation with the Complainant**. On this basis, the Complainant concludes that the Disputed Domain Name is confusingly similar to the Complainant's trademarks, namely:

"PAUL SMITH", "  " and "  ".

As a result, the Complainant is of the view that it has satisfied the requirements set out in Paragraph 4(a)(i) of the ICANN Policy.

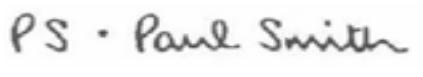
In relation to the Respondent's right or legitimate interest in respect of the Disputed Domain Name, the Complainant drew to the Panel's attention that the Respondent had **never** been authorised by the Complainant to use any of the trademarks, namely: "PAUL SMITH", "  " and "  " under any circumstances. Additionally, it is also submitted that the Respondent has **no business relationship** with the Complainant and its Group companies. Thus, the Complainant advocates that the Respondent **does not** have any rights with regard to the trademarks.

For the foregoing reasons, the Complainant submits that the Respondent **DOES NOT** have any rights or legitimate interests in relation to the Disputed Domain Name. Thus, the Complainant contends that the requirements set out in Paragraph 4(a)(ii) of the Policy has been satisfied.

In regards to the Respondent's bad faith in registering and using the Disputed Domain Name, the Complainant submits that the Disputed Domain Name website is selling fake counterfeit products bearing the Complainant's registered trademarks, namely: "PAUL SMITH", "  " and "  ".

The Complainant further submits that the products sold on the Disputed Domain Name website were named as "PAUL SMITH" products. On this basis, the Complainant contends that the Respondent's conduct should be regarded as evidence

of bad faith as prescribed in Paragraph 4(b)(iv) of the ICANN Rules.

In respect of the allegation that the Respondent was aware of the Complainant's trademarks well before registering the Disputed Domain Name, the Complainant submits that the trademarks, namely: "PAUL SMITH", "  " and "  ", had been used extensively registered throughout the world including the United Kingdom, United States of America, and China.

The Complainant repeatedly submits that the Respondent is using the Disputed Domain Name to sell fake counterfeit products bearing the Complainant's prior registered trademarks. On this basis, the Complainant was of the opinion that **it can be reasonably inferred that the Respondent was aware of the Complainant's prior trademarks well before registering the Disputed Domain Name**.

The Respondent

On 8 November 2012, the Disputed Domain Name "paulsmithensoldes.com" was registered by HICHINA ZHICHENG TECHNOLOGY LTD, and the holder of the Disputed Domain Name, as noted by the Registrar's email of 11 July 2013, was Wenzhuo Chen.

On 13 August 2013, the ADNDRC-HK through an email informed the Complainant that the Respondent has not responded to the ADNDRC-HK within the stipulated timeframe (i.e. on or before 12 August 2013). As such the Respondent has not contested the allegations of the Complainant and is in default.

5. Findings

A. Language of the Proceedings

According to Paragraph 11(a) of the ICANN Rules, it provides that:

"***Unless otherwise agreed by the Parties, or specified otherwise in the***

> ***Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.***"

In the present case, the Parties had not agreed a particular language for these proceedings. Nevertheless, as noted by the ADNDRC-HK through an email of 15 July 2013, the Registration Agreement is in the Chinese language. As a result, in accordance with Paragraph 11(a) of the ICANN Rules, the language of the administrative proceedings shall be in Chinese.

Nevertheless, on 23 July 2013, the Complainant requested the Panel to adopt English as the language of the administrative proceedings, and stated that:

> "*The reasons for this request are as follows: there would be an* ***additional cost to the Complainant to translate*** *this Complaint and this would be inequitable given the damage that has been suffered to date in this matter by the operation of the infringing website. Further, it is* ***unnecessary to incur such cost since we have written to the Registrar on several occasions****, we have called and we know that the Registrar can conduct these proceedings in English. Furthermore, the Registrar has been* ***given numerous opportunities to assist us*** *in taking action against the infringing website but has, to date,* ***not acknowledged our emails and telephone calls***."

Given that the Respondent has not responded to the complaint nor sought assistance of the ADNDRC-HK under these circumstances, the Panel would allow the Complainant's request and would consider it appropriate (and without prejudice to any of the parties) for the present proceedings to be conducted in the language of "English". However, in the spirit of equality and fairness, the Panel shall also provide a Chinese version of the Decision for the Parties reference.

B. Discussion and Findings

Having considered all the documentary evidence before me, and the Respondent's non-participation in these proceedings after being afforded every opportunity to do so

in accordance with Paragraph 5(e) of the ICANN Rules, the Panel is of the view that it should proceed to decide the Disputed Domain Name, namely, "paulsmithensoldes.com" based upon the Complaint and evidence as adduced by the Complainant. Paragraph 5(e) of the ICANN Rules stated as follows:

> "***If a Respondent does not submit a timely Response, in the absence of exceptional circumstance, the Panel shall decide the dispute based upon the Complaint.***"

Having said so, Paragraph 4(a) of the ICANN Policy, which is applicable hereto, the Complainant has the burden of proving the following elements:

(i). the Disputed Domain Name is **identical or confusingly similarity** to a trade mark or service mark in which the Complainant has rights; and

(ii). the Respondent has **no legitimate interests** in respect of the Disputed Domain Name; and

(iii). the Disputed Domain Name is **registered** and is being **used in bad faith**.

(1). Identical/confusing similarity

Paragraph 4(a)(i) of the ICANN Policy requires the Complainant to prove that the Disputed Domain Name is **identical** or **confusingly similar** to a trademark or service mark in which the Complainant has rights.

In the case of Zurich Insurance Company Ltd v Bras Juncs (KLRCA/ADNDRC's Decision, Case No: KLRCA/ADNRC-150-2013)(Dated 2 August 2013)("Zurich Insurance Company"), the Panel found that:

> "*... The Complainant has adduced sufficient evidence to demonstrate that it is a* ***registered proprietor of the ZURICH trade marks in various jurisdictions*** *including Argentina, Brazil, Canada and Malaysia. The disputed domain name Zurich-Insurances.com incorporates the Complainant's Zurich and/or Zurich*

Insurance trade marks"

From this, the Panel concluded that, "*the disputed domain name is identical or confusingly similar to the Complainant's Zurich trade marks*". Similarly, in the case of Paul Smith Group Holdings Limited v Sundi Yalerl (ADNDRC's Decision. Case No: HK-1300518)(Dated 10 July 2013)("Paul Smith Group Holdings Limited"), the Panel was of the view that:

"*... the mere addition of the term 'sale' which is a generic term and of the geographical term 'UK'* ***does nothing to distinguish it from the Complainant's trademarks 'PAUL SMITH' and "Paul Smith" but rather increases the likelihood of confusion***. *("the addition of 'uk' and 'sale' is* ***not sufficient to avoid but rather increases the risk or Internet user confusion in relation to the Complainant's trademarks****', WIPO Case No. D2012-1348, 'Dr. Martens' International Trading GmbH, 'Dr. Martens' Marketing GmbH v. Private Whois Service, Suspended Domain/ Fundacion Private Whois")*)

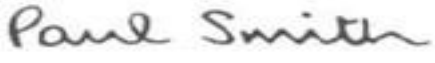
Likewise, in the case of Deutsche Telekom AG v Zhao Ke (ADNDRC's Decision. Case No: HK-1300495)(Dated 26 June 2013)("Deutsche Telekom AG"), the Panel was of the view that:

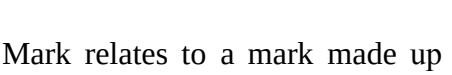
"*The Complainant owns more than 800 trade mark registrations for or incorporating 'T-Systems' in* ***more than 60 countries worldwide, including 22 in the People's Republic of China ('PRC'). The Panel finds that the Complaint has rights in the <T-Systems> mark acquired through registration****. The <T-Systems> mark has been registered worldwide including in Germany, USA and China, and the Complainant has a widespread reputation in telecommunication industry in the world*"

By applying the principles stipulated in Zurich Insurance Company, Paul Smith Group Holdings Limited as well as Deutsche Telekom AG, this Panel has to consider whether the Disputed Domain Name, namely, "paulsmithensoldes.com" is **a central and distinguishable part of the Complainant's trademarks**.

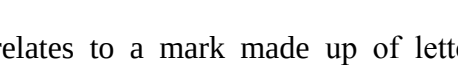
In the present case, as akin to the facts of Zurich Insurance Company as well as Deutsche Telekom AG, the Complainant and its Group companies is the registered proprietor of the trademarks in various jurisdictions.

For instance, the Complainant is the owner of the United Kingdom trademark registration number UK00001190572 with an actual date of registration of 16 February 1983. The Trade Mark relates to a mark made up of letters "  " The Trade Mark is currently registered in Class 25.

The Complaint is also the owner of the United Kingdom trademark registration number UK00002051161 with an actual date of registration of 16 May 1997. The Trade Mark relates to a mark made up of letters "PAUL SMITH" and "  ". The Trade Mark is currently registered in Class 3, 8, 9, 14, 16, 18, 21, 24, 25 and 34.

The Complainant is also the owner of the United Kingdom trademark registration number UK00002184370 with an actual registration date of 4 June 1999. The Trade Mark relates to a mark made up of letters "  ". The Trade Mark is currently registered in Class 25.

Additionally, the Complainant is the owner of the WIPO trademark registration number 0000755406 with an actual registration date of 20 March 2001. The Trade Mark relates to a mark made up of letters "PAUL SMITH" and has been granted protection in many countries including the United Kingdom, China, Czech Republic, Hungary, Iceland, Monaco, Poland, Romania, Serbia and Montenegro. The Trade Mark is currently registered in Class 03, 09, 14, 16, 18 and 25.

Likewise, the Complainant is also the owner of the WIPO trademark registration number 0000988039 with an actual registration date of 5 June 2008. The Trade Mark relates to a mark made up of letters "  " and has

acquired protection in many countries including the United Kingdom and Bahrain. The Trade Mark is currently registered in Class 03, 09, 14, 16, 18 and 25.

The Complainant is also an owner of the WIPO trademark registration number 0000708450 with an actual registration date of 11 February 1999. The Trade Mark relates to a mark made up of letters "PS · Paul Smith" and has acquired protection in many countries including the United Kingdom, China, Benelux, Switzerland, Czech Republic, Germany, Denmark, Finland, France, Hungary, Iceland, South Korea, Monaco, Norway, Poland, Portugual, Romania, Sweden, Turkey and Serbia and Montenegro. The Trade Mark is currently registered in Class 25.

The Respondent registered the Disputed Domain Name through the Registrar, HICHINA ZHICHENG TECHNOLOGY LTD on 8 November 2012. In contrast, the Complainant registered the first United Kingdom trademark "Paul Smith" in 16 February 1983 and acquired the first WIPO registration trademark of "PS · Paul Smith" in 11 February 1999, twenty-nine (29) years and thirteen (13) years retrospectively before the Respondent registered the Disputed Domain Name.

The Complainant advocates that the Disputed Domain Name is the same and it is a **central and distinguishable** part of the Complainant's registered trademarks including "PAUL SMITH", "Paul Smith" as well as "PS · Paul Smith". In saying so, the Panel is of the opinion that the additional "en" and "soldes" does nothing "***to distinguish it from the Complainant's trademarks 'PAUL SMITH' and "Paul Smith" but rather increases the likelihood of confusion***". As a result, the Panel concurs with the Complainant's view that the Disputed Domain Name can "***easily mislead consumers*** *to* ***mistakenly believe*** *the Disputed Domain Name is owned or operated by the Complainant, or the Respondent has certain relation with the Complainant*".

As stated previously, the Respondent has not contested the allegations of the Complainant and is in default.

For the foregoing reasons, this Panel concludes that the Complainant **has discharged** its burden of proof to establish the elements of identical and confusingly similar mark in accordance with Paragraph 4(a)(i) of the ICANN Policy.

(2). Rights or Legitimate Interests of Respondent

Paragraph 4(c) of the ICANN Policy sets out the examples of circumstances where the Respondent may have rights or legitimate interests over the Disputed Domain Name:

> "***c. How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name to Complaint*** *... any of the circumstances, in particular* ***but without limitation****, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):*
>
> *(i) before any notice to you of the dispute, your use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;* ***or***
>
> *(ii) you (as individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service marks;* ***or***
>
> (iii) *you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to* ***misleadingly divert consumers or to tarnish the trademark or service mark at issue***."

In the case of Zurich Insurance Company, the Panel found that:

> "*In the light the Respondent's failure to proffer any explanations and jusifications, the Panel finds that there is* ***no evidence on record*** *to demonstrate that the Respondent has rights or legitimate interests in respect of the disputed domain name … The Respondent* ***has not been authorised by the Complainant to operate the website or provide its services by reference to the Complainant's Zurich trade marks***."

In that case, the Panel concluded that the Respondent has failed to establish any right or legitimate interest in relation to the Disputed Domain Name.

Similarly, in the case of Paul Smith Group Holdings Limited, the Panel observed that:

> "*… the Complainant did not authorise or license the Respondent to use the 'PAUL SMITH' and "Paul Smith" trademarks (see RIO TINTO LONDON LIMITED v. li cheng, ADNDRC Case n CN-0900272)*"

The Panel went further and stated that:

> "*Likewise, the Respondent* ***does not seem to have a legitimate project linked to the Disputed Domain Name*** *and it seems* ***rather unlikely*** *that a domain name containing the first name "Paul" and what appears to be the family name "Smith" could have been registered in ignorance of the well-known prior trademark PAUL SMITH …*"

Likewise, in the case of Deutsche Telekom AG, the Panel found as follows:

> "*The Panel accepts that … Respondent lacks any rights or legitimate interests, and* ***by virtue of its default, the Respondent has failed to come forward with any evidence to rebut that finding (including the examples listed in paragraph 4(c) of the Policy***"

Additionally, the Panel went further and asserted that:

> "*The Respondent was never commonly known as 'T-Systems'. A Google search*

> *turns up no results relating to the Respondent. On the other hand,* ***Google results turn up many hits related to the Complainant, who owns the trademark in 'T-Systems'***"

In the present case, it is proven that the Disputed Domain Name is a **central and distinguishable** part of the Complainant's registered trademarks, namely, "PAUL SMITH", "Paul Smith" as well as "PS · Paul Smith". As mentioned, the Complainant had been using its trademarks "Paul Smith" for twenty-nine years (since 1983). Also, the Panel is of the opinion that the word "paulsmithensoldes" **does not in any way reflect the Respondent's name** (Wenzhuo Chen) nor has the Respondent registered a company name or business name reflecting the word "paulsmithensoldes". Thus, there is **NO EVIDENCE** suggested that "paulsmithensoldes" is the Respondent's legal name.

Likewise, in the present case, there is **NO EVIDENCE** suggested that the Respondent is **commonly known** to the name of "paulsmithensoldes". In fact, the Complainant submits that its Group companies has **NEVER** authorised the Respondent to use its registered trademarks, namely, "PAUL SMITH", "Paul Smith", "PS · Paul Smith" or any other name or mark of the Complainant's Group.

Furthermore, in the present case, as akin to the facts stipulated in Deutsche Telekom AG, the Complainant submits to this Panel that, "*Using WWW.GOOGLE.COM the Complainant searched for 'PAUL SMITH' and obtained 512,000,000 results. Using WWW.GOOLE.COM.HK the Complainant searched for 'PAUL SMITH' and obtained 31,100,000 results. The information* ***on the first page of the search result is associated to the Complainant***". From this, the Panel made a further attempt and search "PAUL SMITH" in the Google Searching Engine (See: WWW.GOOGLE.COM) and obtained 441,000,000 results instead. Nevertheless, the Panel concurred with the Complainant's observations that "***The information on the***

first page of the search result is associated to the Complainant".

By applying the principles as stipulated in Zurich Insurance Company, Paul Smith Group Holdings Limited as well as Deutsche Telekom AG, this Panel concludes that the Respondent has **NO RIGHT** and/or **LEGITIMATE INTEREST** in respect of the Disputed Domain Name.

(3). Bad Faith

Paragraph 4(b) of the ICANN Policy sets out four (4) factors in which the Panel will need to examine to determine whether the Respondent has registered and used the Disputed Domain Name in bad faith. The four (4) factors are as follows:-

> "***b. Evidence and Registration and Use in Bad Faith:*** *For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present,* ***shall be evidence of the registration and use of a domain name in bad faith****:*
>
> *(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name;* ***or***
>
> *(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct;* ***or***
>
> *(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor;* ***or***
>
> *(iv) by using the domain name, you have intentionally attempted to*

> *attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complaint's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.*"

In the case of Zurich Insurance Company, the Panel held that:

> "*The Complainant has repeatedly stated that the Respondent has registered the disputed domain name in bad faith as there was a clear intention that the Respondent, by operating a website using the disputed domain name,* ***deliberately misrepresents to potential customers that the Respondent's website is somehow connected to or associated with the Complainant***"

The Panel went further and reinstated that:

> "*... the Respondent has created a situation whereby* ***users are likely to be misled or confused into thinking that the Respondent's website is connected to or at least associated with the Complainant*** *and the Respondent is using the disputed domain name* ***for the purposes of and with the intention to mislead or deceive potential customers of the Complaint's services to its website***"

Likewise, in the case of Paul Smith Group Holdings Limited, the Panel observed that:

> "*... the Panel admits that it is possible that* ***Respondent used the domain name in dispute to prevent the Complainant from reflecting its trademarks in the Disputed Domain Name and for the purpose of financial gains by capitalizing on its reputation and goodwill****. This type of use* ***constitutes sufficient evidence of bad faith*** *of the Respondent under paragraph 4(b)(iv) of the policy. (see Inter Ikea System B.V., Delft, the Netherlands/Isaac Goldstein, Hong Kong, aforementioned). Respondent has not provided any reply contradicting the reasoning*"

In gist, in relation to the issue of the Respondent's inaction, the Panel commented as follows:

> "*Indeed, bad faith of a domain name is not limited to a positive action. Inaction can also be regarded as acting out of bad faith.* ***Previous Panels have already considered that passive holding of a domain name can satisfy the requirements of paragraph 4(a)(iii)*** *...*"

In the meantime, in the case of Deutsche Telekom AG, the Panel found that:

> "*The amount that the Respondent has demanded for sale of the Disputed Domain Name indicates that he is aware of the value of the Complainant's marks and its associated goodwill and is trading on that value. Moreover,* ***the Respondent did not respond formally to the Complainant. The Panel therefore concludes that the disputed domain names were used by the Respondent in bad faith***."

In the present case, as akin to the case of Zurich Insurance Company, the Complainant's Group companies had registered the United Kingdom trademark of "Paul Smith" since 16 February 1983 and the WIPO trademark of "PS · Paul Smith" since 11 February 1999. The Panel is convinced that the Complainant had used the trademarks thereon extensively for marketing purposes throughout the world, *inter alia*, in China (The Respondent, Wenzhuo Chen is an individual who resides in China).

On this basis, the Panel is of the view that it would be inconvincible for the Respondent to argue that it was unaware of the Complainant's registered trademarks, namely, "PAUL SMITH" and "Paul Smith", at the time the Disputed Domain Name was registered on 8 November 2012.

The mere explanation of what has happened is that the Respondent's motive in registering the Disputed Domain Name ("paulsmithensoldes.com") seems to be, as the Complainant says, "***using the Disputed Domain Name to sell fake counterfeit products bearing with the Complainant's prior registered trademarks***". On this basis, the Panel is of the opinion that the Respondent registered the Disputed Domain Name

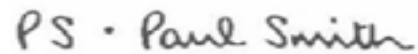
deliberately in order to capture the goodwill of "PAUL SMITH", "  ", "" trademarks as well as wishes to profit from the goodwill associated with the trademarks thereon.

Additionally, in the present case, as akin to the case of Zurich Insurance Company, the Respondent's using of the Disputed Domain Name website as a mean to sell fake counterfeit products pertaining to the Complainant's trademark (See: <http://www.paulsmithensoldes.com>)is relevant to the Panel's determination of the case on hand. As a result, the Panel is of the view that the Respondent has created a situation whereby Internet users **are likely to be misled or confused into thinking** that the Respondent's website is connected to or at least associated with the Complainant. Here, the Panel is of the opinion that such conduct is simply unacceptable, and is material in proving that the Respondent registered and used the Disputed Domain Name in bad faith.

By applying the principles stipulated in Zurich Insurance Company, Paul Smith Holdings Group Limited as well as Deutsche Telekom AG coupled with the information hereinabove, the Panel is of the view that the Respondent has **NO good cause or any justifiable reasoning** of using the Disputed Domain Name.

For the foregoing reasons, the Panel concludes that the Respondent **registered** and used the contested domain name in **bad faith**, in light of Paragraph 4(b) of the ICANN Policy.

6. Conclusion

The Complainant has proved its case. It has registered trademarks in the name of "PAUL SMITH", "  " as well as "  " to which the contested dispute name **is confusingly similar**.

The Respondent has shown **no right or legitimate interest** in the Disputed Domain

Name.

The Complainant has proved that the Respondent has **registered** and **used** the Disputed Domain Name **in bad faith**.

For the foregoing reasons and in accordance with Paragraph 4 of the ICANN Policy, the Panel concludes that the relief requested by the Complainant be granted and do hereby ordered that the Disputed Domain Name, namely, "paulsmithensoldes.com" **BE TRANSFERRED** to the Complainant Paul Smith Group Holdings Limited.

Dated: 16th September 2013

_____

Christopher To

ADNDRC Asian Domain Name Dispute Resolution Centre hong kong

亚洲域名争议解决中心
（香港秘书处）

统一域名争议解决政策

专家组裁决书

案件编号：HK-1300526

投诉人： 保罗史密斯集团控股有限公司
(PAUL SMITH GROUP HOLDINGS LIMITED)

被投诉人：**WENZHUO CHEN**

争议域名：**paulsmithensoldes.com**

注册商： 北京万网志成科技有限公司（中国万网）
HICHINA ZHICHENG TECHNOLOGY LTD

专家组成員： 陶荣

---

1. 当事人及争议域名

本案的投诉人是保罗史密斯集团控股有限公司(Paul Smith Group Holdings Limited)，其英文的地址是 The Poplars, Lenton Lane, Nottingham, NG7 2PW, Great Britain.

被投诉人是 **Wenzhuo Chen**，其英文的地址是 Beijing Zhongqingshi, Jiulongpoqu,

Huangjuepingjie 108hao, 400053, China.

本案争议域名“paulsmithensoldes.com”的注册商是北京万网志成科技有限公司（中国万网）(HICHINA ZHICHENG TECHNOLOGY LTD) ，其英文的地址是 3/F HiChina Mansion27 Gulouwai Avenue, Dongcheng District, Beijing, 100120, China.

2. 案件程序

投诉人於 2013 年 7 月 9 日 ，依据互联网络名称与数字地址分配机构(“ICANN”) 施行的《统一域名争议解决政策》(以下简称“解决政策”)、ICANN 批准的《统一域名争议解决政策之规则》(以下简称“议事规则”) 及亚洲域名争议解决中心施行的《统一域名争议解决政策的补充规则》(以下简称“补充规则”)向亚洲域名争议解决中心香港秘书处(以下简称“中心香港秘书处”)提交了诉申请书。

中心香港秘书於 2013 年 7 月 10 日发以电邮的方式，发函致本案争议域名的注册商北京万网志成科技有限公司（中国万网）(HICHINA ZHICHENG TECHNOLOGY LTD) <zhaoyang@hichina.com>及 <disputes@hichina.com>。

争议域名的注册商於 2013 年 7 月 11 日发函到亚洲域名争议解决中心香港秘书处确认该域名已被注册。该域名的拥有人是 Wenzhuo Chen。有鑑於此，ICANN 施行的《统一域名争议解决政策之规则》(以下简称“议事规则”)确实能够援引到本案之中。根据 HICHINA ZUICHENG TECHNOLOGY LTD 提供的资料显示(见：<http://www.net.cn>)，争议域名的注册协议使用的語言是中文。直至撰写裁决书之时 ，本案争议域名之网页仍然正常运作(见 :http://www.paulsmithendoes.com)。

中心香港秘书处於 2013 年 7 月 15 日发函致投诉人，确认收到於 2013 年 7 月 9 日提交了的投诉书。 同日，中心香港秘书处让投訴人知悉争议域名的注册协议使用的語言是中文。根据《统一域名争议解决政策之规则》第 11(a)条，该条例说明：

> *(a) 除非当事人另有约定或注册协议另有规定，以及专家组权威人士根据行政解决程序的具体情形另行决定，否则行政程序所使用的语言应与注册协议所使用的语言一致。*
>
> *(b) 如果当事人提交的文本语言与行政程序所用语言不同，专家组可要求当*

事人根据行政程序所用的语言提供该文件的全文或部分翻译。

与此同时，亚洲域名争议解决中心香港秘书处让投诉人知悉其争议域名之注册商名称是"wenzhuo chen"，而並非"wenzhou chen" 。有见及此，中心香港秘书处表示：

> "*因此请投诉人于2013年7月20日或之前修改投诉书及提供中文译本，并抄送至本案注册商（zhaoyang@hichina.com）及被投诉人。*
>
> *如阁下要求以"英文"作为行政程序所使用的语言及希望将有关语言的事宜交由专家组决定，请于以上截至日期前向案件经办人提出并提交相关理由。*"

中心香港秘书处於 2013 年 7 月 22 日向投诉人表示在限定的时间内并没有收到修改之投诉书。中心香港秘书处根据《统一域名争议解决政策之规则》第 4(b)条，指出：

> "*(b) 如果争议解决机构发现投诉书存在形式缺陷，应立即通知投诉人和被投诉人该缺陷。 投诉人应在收到通知后 5 日内纠正该缺陷。如未能在上述期限内纠正，将视为撤销行政程序，但并不妨碍投诉人提起另一不同的投诉。*"

有鉴於此，中心香港秘书处指出：

> "*According to Article 4(b) of the Rules of UDRP, the captioned complaint is deemed to be withdrawn and administrative proceeding is terminated. However,* ***a new complaint concerning the same Domain Name shall can still be re-filed without any impact to it***"

投诉人於 2013 年 7 月 23 日向中心香港秘书处提交了修改的投诉书，并且夹附了本案之证据及文件。同时，投诉人要求专家组使用英文作为行政程序所使用的语言，并且有以下的解释：

> "*The reasons for this request are as follows: there would be an* ***additional cost to the Complainant to translate*** *this Complaint and this would be inequitable given the damage that has been suffered to date in this matter by the operation of the*

*infringing website. Further, it is **unnecessary to incur such cost since we have written to the Registrar on several occasions**, we have called and we know that the Registrar can conduct these proceedings in English. Furthermore, the Registrar has been **given numerous opportunities to assist us** in taking action against the infringing website but has, to date, **not acknowledged our emails and telephone calls**.*"

投诉人於2013年7月23日向中心香港秘书处提交了更改版本的投诉书及相关的行政费用。

中心香港秘书处於 2013 年 7 月 23 日让投诉人知悉本案的案件编号由"HK-1500516"至"HK-1500526"。

中心香港秘书处於2013年7月23日以电子邮件的方式向被投诉人注册了的电子邮件联络地址（根据 WHOIS 所提供的数据显示，被投诉人注册了的电子邮件联络地址是<wmnaie@163.com>）传送程序开始通知书（以下简称通知书）。通知书要求被投诉人在二十天（20）的期限内提交答辩书（即2013年8月12日或之前）。

中心香港秘书处於2013年7月24日未能顺利以传真的方式向被投诉人提交投诉书（见：传真结果报告(TX Result Report)中"Result"一列中的结果是"NO ANSWER"）。有鉴於此，中心香港秘书处另外以邮寄的方式把投诉书及其附件发送到被投诉人以下的地址：

"*Beijing Zhongqingshi,*
Jiulongpoqu,
Huangjuepingjie 108hao,
400053,
Wenzhuo Chen"

中心香港秘书处於2013年8月13日以电子邮件的方式发函致投诉人，并投诉人知悉被投诉人在答辩期限内（即2013年8月12日或之前）未能提交答辩书。因此，被投诉人没有就投诉人提出的指控作出任何回应。

中心香港秘书处於2013年8月21日委任陶荣先生(Mr. Christopher To) 作为独立

专家组。独立专家组於 2013 年 8 月 21 日已收到涉案文件的电子版本。独立专家组於 2013 年 8 月 26 日收到涉案文件的硬本。

根据议事规则第 15 条(a)而言，专家组应根据当事人所提交的陈述及证据裁决本案之争议。

再者，根据议事规则第 15 条(d)而言，专家组将会发出裁决书，并颁布裁决理由书。

3. 事实背景

投诉人的主张

保罗史密斯集团控股有限公司及其公司的分部成员保罗史密斯有限公司於 1983 年 2 月 16 日注册其商标“Paul Smith”(见英国注册商标编号 UK00001190572)。“Paul Smith” 在设计、时装设计和手饰的界别內是国际上富有知名度的的品牌。

经过业务上多年来的发展，“Paul Smith”商标在英国及海外享誉盛名。品牌尤其以优质的原材料及卓越的技术为名，在顶级的零售市场上提供优质的产品。与此同时，投诉人多年来以全球市场推广为名广泛地使用“Paul Smith”的商标。

有关於注册商标的事宜，投诉人是英国商标编号 UK00001190572 的拥有人，并在 1983 年 2 月 16 日将其商标注册。其商标上印有“Paul Smith”等的标语字句。其商标现已注册成为第 25 类的商品类别。

> *Class 25: Scarves, shoes, vests, boxer shorts, jackets, trousers, knitted articles of clothing, articles of clothing made from knitted materials, waistcoats, shirts, suits and coats; belts, ties, socks and gloves; all being articles of clothing; all for*

men

投诉人是英国商标编号 UK00002051161 的拥有人，并在 1997 年 5 月 16 日将其商标注。其商标上印有“PAUL SMITH” 及“  ”等的标语字句。其商标现已注册成为第 3 类、第 8 类、第 9 类、第 14 类、第 16 类、第 18 类、第 21 类、第 24 类、第 25 类和第 34 类的商品类别:

Class 3: Perfumery, colognes; cosmetics; soaps; shampoo, preparations for use for and after shaving, toilet preparations, skin care and hair care preparations, deodorants, anti-perspirants, dentifrices, bath and shower preparations; talcum powder; show cleaning preparations

Class 8: Hand tools and implements (hand operated); cutlery; side arms; razors; knives, penknives; tweezers; manicure sets, pedicure sets, nail clippers, nail files; razor blades, razor cases; scissors; shaving cases.

Class 9: Spectacle frames, sunglasses frames, sunglasses, lenses, clips, cases and containers for spectacles and sunglasses, radios, calculators, parts and accessories for all the aforesaid goods;

Class 14: Precious metals and their alloys and goods inprecious metals or coated therewith, not included in other Classes, jewellery, precious stones, horological and chronometric instructments, imitation jewellery, brooches, cuff-links, ornamental pins, tie pins, watches, watch straps, clocks, money clips, key rings.

Class 16: Paper; cardboard and cardboard articles; stationery, printed matter, printed publications, calendars, albums, writing materials and writing implements, notebooks, note pads, diaries, address books, posters, loose-leaf binders, files, folders; pen and pencil sets, cases and standards; letter racks, paper knives, cards, playing cards, paperweights, parts and fittings for all the aforesaid goods.

Class 18: Leather and imitations of leather; and goods made of these materials

not included in other Classes; animals skins; hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; luggage; rucksacks, bags, briefcases, pocket wallets, purses, pouches, credit card holders, chewing gum holders, notebook holders, coin holders, key cases.

Class 21: Soap boxes, hair brushes, combs, comb cases, brushes for footwear, nail brushes, shaving brushes, shaving brush stands, toothbrushes, clothes brushes, toilet, shoe horns, shoe trees, household and kitchen utensils and containers.

Class 24: Textiles and textile goods, not included in other Classes; bed and table covers; blankets, rugs, towels, face flannels, handkerchiefs.

Class 25: Articles of clothing, footwear, headgear; gloves, scarves, shawls, belts, braces, ties.

Class 34: Tobacco; smoker's articles; matches; lighters, cigarette cases, cigar cases.

投诉人是英国商标编号 UK00002184370 的拥有人，并在 1999 年 6 月 4 日将其商标注。其商标上印有“PS · Paul Smith ”等的标语字句。其商标现已注册成为第 25 类的商品类别。

投诉人是 WIPO 商标编号 0000755406 的拥有人，并在 2001 年 3 月 20 日将其商标注。并且在世界范围内（包括英国、美国、中国、捷克、匈牙利、冰岛、摩纳哥、波兰、罗马尼亚、塞尔维亚及黑山等）把印有“PAUL SMITH” 标语字句的商标注册。其商标现已注册成为第 3 类、第 8 类、第 9 类、第 14 类、第 16 类、第 18 类和第 25 类的商品类别。

投诉人是 WIPO 商标编号 0000988039 的拥有人，并在 2008 年 6 月 5 日将其商标注。并且在英国及巴林把印有“Paul Smith ”标语字句的商标注册。其商标现已注册成为第 3 类、第 9 类、第 14 类、第 16 类、第 18 类和第 25 类的商品类别。

有見及此，投诉人认为上述的注册商标，包括“PAUL SMITH”、“  ”及“”已在全球享誉盛名，多年来以全球市场推广为名广泛地使用"Paul Smith"的商标。

投诉人於 2013 年 7 月 5 日的投诉书中指出，“*Using WWW.GOOGLE.COM the Complainant searched for 'PAUL SMITH' and obtained 512,000,000 results. Using WWW.GOOLE.COM.HK the Complainant searched for 'PAUL SMITH' and obtained 31,100,000 results. The information* ***on the first page of the search result is associated to the Complainant***”。

被投诉人的主张

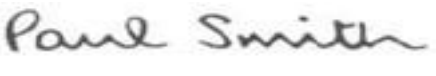
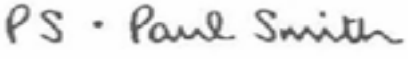
被投诉人 Wenzhuo Chen 的现址是位置於中华人民共和国。

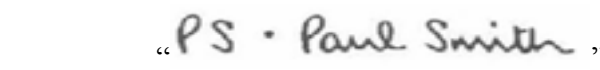
注册商北京万网志成科技有限公司（中国万网）HICHINA ZHICHENG TECHNOLOGY LTD 於 2012 年 11 月 8 日把争议域名<paulsmithensoldes.com>註冊。根据注册商於 2013 年 7 月 11 日发出的电子邮件指出，争议域名的拥有人是 Wenzhuo Chen。

中心香港秘书处於 2013 年 8 月 13 日以电子邮件的方式发函致投诉人，并且让投诉人知悉被投诉人在答辩期限内(即 2013 年 8 月 12 日或之前)未能向中心香港秘书处提交答辩书。

4. 当事人主张

投訴人的主張

投訴人指出其公司是“PAUL SMITH”、“  ”及“  ”的商标注册拥有人。

投诉人指出本案之域名极易拆分为“*‘paulsmith’* + *‘en’* + *soldes*”进行识别。投诉人向专家组明示"en"及"soldes"作为一个一般性法文词汇，具有"in"及"sales"的意义。有见及此，投诉人向专家组指出争议域名极易具备「**法国售卖 PAUL SMITH 产品的网站**」之义(原文：***the French sale website for PAUL SMITH goods***)。投诉人向专家组指出其商标，即“PAUL SMITH”、“  ”及“  ”是争议域名的主要及可识别的因素。

投诉人指出争议域名指向的网站公然地大量销售假冒的 PAUL SMITH 产品。此举印证被投诉人的意图使用争议域名具备「法国售卖 PAUL SMITH 产品的网站」之义。

投诉人向专家组表示争议域名指向的网站内存载著一些图片及商品。这些图片及商品实际上及实质上与投诉人所注册的商标非常近似，即“PAUL SMITH”,“  ”及“”。有鉴於此，投诉人指出被投诉人企图以上述网站塑造为销售保罗史密斯产品的法国官方网站。

综合上述的理据，投诉人指出本案争议之域名极易**误导消费者错误地认为争议域名为投诉人所有，或者误认为被投诉人与投诉人之间存在一定的关联关系**。有见及此，投诉人的结论是本案争议域名与投诉人之商标，即“PAUL SMITH”、“  ”及“”确实构成混淆性相似。

投诉人认为此举已满足《统一域名争议解决政策》第 4(a)(i)条规定的举证责任。

有关被投诉人对争议域名的权利及合法利益的事宜，投诉人向专家组指出未以任何形式授权被投诉人使用任何其注册之商标，即“PAUL SMITH”、“  ”及“”。投诉人更指出被投诉人与投诉人亦**无商务来往**。因此，被投诉人对上述之商标**并没有**任何形式的商标权。

投诉人指出被投诉人对争议之域名并没有任何权利或合法权益。因此，投诉人认为此举满足《统一域名争议解决政策》第四(a)(ii)条规定的举证责任。

有关於被投诉人出於恶意注册并使用争议域名的事宜，被投诉人将其用於建站并公然销售印有投诉人注册商标的假冒产品，即“PAUL SMITH”、“Paul Smith”及“PS · Paul Smith”。

投诉人进一步表示，於本案争议域名网页中售卖的商品，均被名为"PAUL SMITH"商品。有鉴於此，根据《统一域名争议解决政策之规则》第 4(b)(iv)条，投诉人认为应把被投诉人的行为，视作恶意注册和使用域名的证据。

有关於被投诉人在注册争议域名时已熟知投诉人商标的指控，投诉人指出“PAUL SMITH”、“Paul Smith”及“PS · Paul Smith”等商标已在全球各地，包括英国、美国及中国，已由投訴人广泛注册。

投诉人重申，被投诉人在争议域名所指向的网站销售具有投诉人现有注册商标的产品。投诉人认为此举在合理的推断下证明了被投诉人是在熟知投诉人上述之现有注册商标的情况下注册争议域名。

被投诉人的主张

注册商北京万网志成科技有限公司（中国万网）HICHINA ZHICHENG TECHNOLOGY LTD 於在 2012 年 11 月 8 日把本案争议之域<paulsmithensoldes.com＞注册的。根据注册商於 2013 年 7 月 11 日发出的电子邮件指出，本案域名的拥有人是 Wenzhuo Chen。

中心香港秘书处於 2013 年 8 月 13 日以电子邮件的方式发函致诉人，并且让投诉人知悉被投诉人在答辩期限内(即 2013 年 8 月 12 日或之前)未能向中心香港秘书处提交答辩书。

5. 专家组的意见

A. 行政程序的语言

根据《统一域名争议解决政策之规则》第 11(a)条，该条例说明：

> *(a) 除非当事人另有约定或注册协议另有规定，以及专家组权威人士根据行政解决程序的具体情形另行决定，否则行政程序所使用的语言应与注册协议所使用的语言一致。*

依据本案之案情而论，争议双方并没有就行政程序所使用的语言上达成任何共识。尽管如此，中心香港秘书处於 2013 年 7 月 15 日时确认注册协议上规定使用之语言是中文。因此，根据《统一域名争议解决政策之规则》第 11(a)条，本案之行政程序所使用的语言該爲中文。

然而，投诉人於 2013 年 7 月 23 日则向专家组要求更改行政程序所使用的语言为英文，原因如下：

> "*The reasons for this request are as follows: there would be an **additional cost to the Complainant to translate** this Complaint and this would be inequitable given the damage that has been suffered to date in this matter by the operation of the infringing website. Further, it is **unnecessary to incur such cost since we have written to the Registrar on several occasions**, we have called and we know that the Registrar can conduct these proceedings in English. Furthermore, the Registrar has been **given numerous opportunities to assist us** in taking action against the infringing website but has, to date, **not acknowledged our emails and telephone calls**.*"

考虑到被告未有就投诉作出回应，亦未有向亚洲域名争议解决中心寻求协助，有鉴於上述的情况，专家组将接纳投诉人所述的原因，並裁定本案之行政程序的语言（基於不妨碍任何争议双方的原则）为英文。然而，基於公平及公正的原则下，专家组将会为本案之裁决书提供中文版本，以供各方参考。。

B. 讨论及意见

经过详细地考虑所有提供给专家组的证供，被投诉人曾给予多次机会作出回应，但最终也没有参与本案之程序。根据《统一域名争议解决政策之规则》第 5(e)条，专家组应依据投诉书及提交之证据裁决有关争议域名"paulsmithensoldes.com"之纠纷。《统一域名争议解决政策之规则》第 5(e)条说明如下：

> *(e) 如果被投诉人未提交答辩，如无特殊情形，专家组应依据投诉书裁决争议。*

与此同时，《统一域名争议解决政策》第4(a)条确实适用於本案之中。投诉人具有举证的责任证明下列的元素:

> *(i) 你方的域名与投诉人拥有的商标或服务标记**相同**或极其相似，容易引起混淆；以及*
>
> *(ii) 你方**不拥有**对该域名的权利或**合法利益**；以及*
>
> *(iii) 你方的域名已被**注册**并且正被**恶意使用**。*

(1.)相同／混淆性地相似

根據《统一域名争议解决政策》第 4(a)(i)条，投訴人必须证明争议域名与持有的商标或服务有**相同**或**混淆性地相似**的关系。

在 Zurich Insurance Company Ltd v Bras Juncs (KLRCA/ADNDRC's Decision, Case No: KLRCA/ADNRC-150-2013)(Dated 2 August 2013)("Zurich Insurance Company")一案中，专家组有以下的发现：

> "*... The Complainant has adduced sufficient evidence to demonstrate that it is a **registered proprietor of the ZURICH trade marks in various jurisdictions** including Argentina, Brazil, Canada and Malaysia. The disputed domain name Zurich-Insurances.com incorporates the Complainant's Zurich and/or Zurich Insurance trade marks*"

因此，专家组有以下之结论，“*the disputed domain name is identical or confusingly similar to the Complainant's Zurich trade marks*”。在 Paul Smith Group Holdings Limited v Sundi Yalerl (ADNDRC's Decision. Case No: HK-1300518)(Dated 10 July 2013)(“Paul Smith Group Holdings Limited”)一案中有近似的见解，专家组在该案中有以下的看法：

> “*... the mere addition of the term 'sale' which is a generic term and of the geographical term 'UK'* ***does nothing to distinguish it from the Complainant's trademarks 'PAUL SMITH' and "Paul Smith" but rather increases the likelihood of confusion***. *("the addition of 'uk' and 'sale' is* ***not sufficient to avoid but rather increases the risk or Internet user confusion in relation to the Complainant's trademarks***', *WIPO Case No. D2012-1348, 'Dr. Martens' International Trading GmbH, 'Dr. Martens' Marketing GmbH v. Private Whois Service, Suspended Domain/ Fundacion Private Whois")*

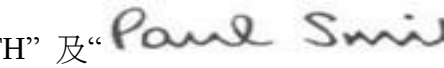
专家组在 Deutsche Telekom AG v Zhao Ke (ADNDRC's Decision. Case No: HK-1300495)(Dated 26 June 2013)(“Deutsche Telekom AG”) 一案中也有同样的看法：

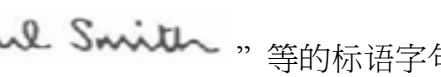
> “*The Complainant owns more than 800 trade mark registrations for or incorporating 'T-Systems' in* ***more than 60 countries worldwide, including 22 in the People's Republic of China ('PRC'). The Panel finds that the Complaint has rights in the <T-Systems> mark acquired through registration***. *The <T-Systems> mark has been registered worldwide including in Germany, USA and China, and the Complainant has a widespread reputation in telecommunication industry in the world*”

基於 Zurich Insurance Company, Paul Smith Group Holdings Limited 及 Deutsche Telekom AG 所定下的原则。本案的专家组需要考虑的是，到底争议域名“paulsmithensoldes.com”的**主体性及识别性与投诉人持有的商标是否相同**。

本案的案情与 Zurich Insurance Company 及 Deutsche Telekom AG 等案的案情十分相近。本案的投诉人在众多的国家内注册了上述的商标。

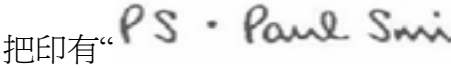
当中包括，投诉人是英国商标编号 UK00001190572 的拥有人，并在 1983 年 2 月 16 日将其商标注册。其商标上印有“  ”等的标语字句。其商标现已注册成为第 25 类的商品类别。

投诉人是英国商标编号 UK00002051161 的拥有人，并在 1997 年 5 月 16 日将其商标注。其商标上印有“PAUL SMITH” 及“  ”等的标语字句。其商标现已注册成为第 3 类、第 8 类、第 9 类、第 14 类、第 16 类、第 18 类、第 21 类、第 24 类、第 25 类和第 34 类的商品类别。

投诉人是英国商标编号 UK00002184370 的拥有人，并在 1999 年 6 月 4 日将其商标注。其商标上印有“  ” 等的标语字句。其商标现已注册成为第 25 类的商品类别。

再者，投诉人是 WIPO 商标编号 0000755406 的拥有人，并在 2001 年 3 月 20 日将其商标注册。并且在世界范围内（包括英国、美国、中国、捷克、匈牙利、冰岛、摩纳哥、波兰、罗马尼亚、塞尔维亚及黑山等）把印有“PAUL SMITH” 标语字句的商标注册。其商标现已注册成为第 3 类、第 8 类、第 9 类、第 14 类、第 16 类、第 18 类和第 25 类的商品类别。

投诉人是 WIPO 商标编号 0000988039 的拥有人，并在 2008 年 6 月 5 日将其商标注。并且在英国及巴林把印有“  ” 标语字句的商标注册。其商标现已注册成为第 3 类、第 9 类、第 14 类、第 16 类、第 18 类和第 25 类的商品类别。

投诉人是 WIPO 商标编号 0000708450 的拥有人，并在 1999 年 2 月 11 日将其商标注。并且在世界范围内（包括英国、中国、比荷卢三国关税同盟、瑞士、中国、捷克、德国、芬兰、法国、匈牙利、冰岛、摩纳哥、韩国、波兰、罗马尼亚、瑞典、土耳其、塞尔维亚及黑山等）把印有“  ” 标语字句的商标注册。其商标现已注册成为第 25 类的商品类别。

被投诉人经由北京万网志成科技有限公司（中国万网）HICHINA ZHICHENG TECHNOLOGY LTD 注册争议域名的日期是 2012 年 11 月 8 日。相反，投诉人首次於英国注册其商标“Paul Smith”的日期是 1983 年 2 月 16 日。投诉人首次於 WIPO 注册其商标“PS · Paul Smith”的日期是 1999 年 2 月 11 日，投诉人比被投诉人早於二十九年前及十三年前已将其商标注册。

投诉人辩护称，争议域名与投诉人注册的商标，即“PAUL SMITH”、“Paul Smith”及“PS · Paul Smith”的主体性及识别性一致。专家组认为加上"en"及"soldes"两字并没有「***区分与投诉人的商标，这样的做法反之加深了混淆性的可能***」(原文：“***to distinguish it from the Complainant's trademarks 'PAUL SMITH' and "Paul Smith" but rather increases the likelihood of confusion***")。

有鉴於此，专家组认同投诉人之见解，并认同本案争议的域名确实会「**极易误导消费者错误地认为争议之域名为投诉人所有，或者误认为被投诉人与投诉人之间存在一定的关联关系**」。

承如上述，被投诉人没有提出任何答辩。

综合上述的原因，专家组认为投诉人**已经满足**《统一域名争议解决政策》第 4(a)(i)条关於相同或混淆性地相似所规定的举证要求。

(2.)**权利及合法权益**

《统一域名争议解决政策》第 4(c)条指出在下列的情况下，被投诉人可能对争议域名具备权利及合法权益：

> *c. 如何回应投诉，表明你方对域名的权利和合法利益。… 如果专家组根据对其提供的所有证据的评估发现确实存在以下任意情况（特别是以下情况但不仅限于），则可表明你方对该域名的权利或合法利益：*

(i) 在接到争议通知之前，被投诉人已将该域名或与该域名相对应的名称用于或可证明准备用于善意提供商品或服务；或

(ii) 被投诉人（作为个人、企业或其他组织），已因该域名而被公众所知，即使被投诉人尚未获得商品商标或服务商标的权利；或

*(iii) 被投诉人对该域名的使用是合法非商业性或正当的，无意获得商业利益，也无意**误导消费者或损害投诉人商品商标或服务商标记之意图**。*

在 Zurich Insurance Company 一案中，专家組有以下的見解：

"*In the light the Respondent's failure to proffer any explanations and jusifications, the Panel finds that there is **no evidence on record** to demonstrate that the Respondent has rights or legitimate interests in respect of the disputed domain name … The Respondent **has not been authorised by the Complainant to operate the website or provide its services by reference to the Complainant's Zurich trade marks**.*"

在这一宗案件里，专家组得出被投诉人对争议域名并不享有任何权利或合法利益的结论。

在 Paul Smith Group Holdings Limited 一案中，专家组得出近似的看法，并说道：

"*… the Complainant did not authorise or license Respondent to use the 'PAUL SMITH' and "* Paul Smith *" trademarks (see RIO TINTO LONDON LIMITED v. li cheng, ADNDRC Case n CN-0900272*)

专家组补充及指出如下：

"*Likewise, the Respondent **does not seem to have a legitimate project linked to the Disputed Domain Name** and it seems **rather unlikely** that a domain name containing the first name "Paul" and what appears to be the family name "Smith" could have been registered in ignorance of the well-known prior trademark PAUL SMITH …*"

专家组在 Deutsche Telekom AG 一案中同样得出下列的见解：

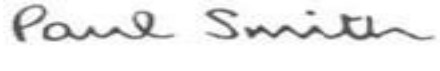
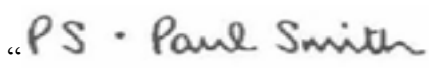
> "*The Panel accepts that ... Respondent lacks any rights or legitimate interests, and* ***by virtue of its default, the Respondent has failed to come forward with any evidence to rebut that finding (including the examples listed in paragraph 4(c) of the Policy***"

专家组补充及确切地指出如下：

> "*The Respondent was never commonly known as 'T-Systems'. A Google search turns up no results relating to the Respondent. On the other hand,* ***Google results turn up many hits related to the Complainant, who owns the trademark in 'T-Systems'***"

根据本案的案情，争议之域名的主体性及识别性与投诉人注册之商标，即"PAUL SMITH"、"  "及""确实一致。

承如上述，投诉人在二十九年前（早在 1983 年）已经把商标注册了。与此同时，专家组也同时认为"paulsmithensoldes"与被投诉人的名字(Wenzhuo Chen)并不相称。专家组也认为没有证据显示被投诉人开设的公司或业务名称与"paulsmithensoldes"相称。有见及此，专家组认为没有证据显示"paulsmithensoldes"是被投诉人的合法名称。

同时，没有证据显示被投诉人被公众所知的名称是"paulsmithensoldes"。事实上，投诉人向专家组提出其集团成员从未以任何形式授权被投诉人使用其注册之商标，即"PAUL SMITH"、"  "及"  "。

再者，本案的案情与 Deutsche Telekom AG 的案情十分吻合。在本案中，投诉人也向专家组提出"*Using WWW.GOOGLE.COM the Complainant searched for 'PAUL*

SMITH' and obtained 512,000,000 results. Using WWW.GOOLE.COM.HK the Complainant searched for 'PAUL SMITH' and obtained 31,100,000 results. The information ***on the first page of the search result is associated to the Complainant***"。有见及此，专家组亲自在 WWW.GOOGLE.COM.HK 中搜寻"PAUL SMITH"并且获得 441,000,000 的结果。尽管如此，专家组认同投诉人之见解，并确认「首页所得出的结果是直属指向投诉人的」(原文："***The information on the first page of the search result is associated to the Complainant***")。

基於 Zurich Insurance Company, Paul Smith Group Holdings Limited 及 Deutsche Telekom AG 所定下的原则。本案专家组得到的总结是被投诉人对争议域名不享有任何权利或合法权益。

(3.)争议域名的注册和使用均为恶意

《统一域名争议解决政策》第 4(b)条规中提供了四项(4)因素给专家组就被投诉人注册和使用争议域名均为恶化意作为裁决的参考。这四项(4)因素包括如下：

> ***b. 恶意注册和使用域名的证据*** *…如果专家组发现存在以下情况（特别是以下情况但不仅限于），则可将其作为恶意注册和使用域名的证据：*
>
> *(i) 一些情况表明，你方已注册域名或已获得域名，主要用于向投诉人（商标或服务标记的所有者）或该投诉人的竞争对手销售、租赁或转让该域名注册，以获得比你方所记录的与域名直接相关之现款支付成本的等价回报还要高的收益；或者*
>
> *(ii) 你方已注册该域名，其目的是防止商标或服务标记的所有者获得与标记相对应的域名，只要你方已参与了此类行为；或者*
>
> *(iii) 你方已注册该域名，主要用于破坏竞争对手的业务；或者*
>
> *(iv) 你方使用该域名是企图故意吸引互联网用户访问你方网站或其他在线网址以获得商业利益，方法是使你方网站或网址或者该网站或网址上的产品或服务的来源、赞助商、从属关系或认可与投诉人的标记具有相似性从而使人产生混淆。*

在 Zurich Insurance Company 一案中，专家组有以下之看法：

"*The Complainant has repeatedly stated that the Respondent has registered the disputed domain name in bad faith as there was a clear intention that the Respondent, by operating a website using the disputed domain name,* ***deliberately misrepresents to potential customers that the Respondent's website is somehow connected to or associated with the Complainant***"

专家组补充并指出：

"*... the Respondent has created a situation whereby* ***users are likely to be misled or confused into thinking that the Respondent's website is connected to or at least associated with the Complainant*** *and the Respondent is using the disputed domain name* ***for the purposes of and with the intention to mislead or deceive potential customers of the Complaint's services to its website***"

在 Paul Smith Group Holdings Limited 一案中，专家组同样地有以下的看法：

"*... the Panel admits that it is possible that* ***Respondent used the domain name in dispute to prevent the Complainant from reflecting its trademarks in the Disputed Domain Name and for the purpose of financial gains by capitalizing on its reputation and goodwill****. This type of use* ***constitutes sufficient evidence of bad faith*** *of the Respondent under paragraph 4(b)(iv) of the policy. (see Inter Ikea System B.V., Delft, the Netherlands/Isaac Goldstein, Hong Kong, aforementioned). Respondent has not provided any reply contradicting the reasoning*"

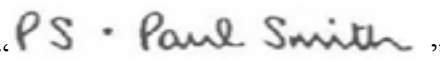
有关被投诉人消极持有的意向，专家组则有如下的见解：

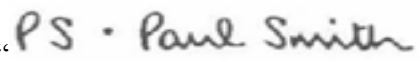
"*Indeed, bad faith of a domain name is not limited to a positive action. Inaction can also be regarded as acting out of bad faith.* ***Previous Panels have already considered that passive holding of a domain name can satisfy the requirements of paragraph 4(a)(iii)*** *...*"

在 Deutsche Telekom AG 一案中，专家组也有以下的看法：

"*The amount that the Respondent has demanded for sale of the Disputed Domain*

Name indicates that he is aware of the value of the Complainant's marks and its associated goodwill and is trading on that value. Moreover, ***the Respondent did not respond formally to the Complainant. The Panel therefore concludes that the disputed domain names were used by the Respondent in bad faith***."

本案的案情跟 Zurich Insurance Company 一案中的案情十分吻合。投诉人及其集团成员早於 1983 年 2 月 16 日时把英国商标"  "注册。及後於 1999 年 2 月 11 日把 WIPO 商标"  "注册。专家组接纳投诉人所述。投诉人以市场推广为名在全球（当中包括被投诉人居住的中国）广泛地使用上述的注册商标。

基於上述的理据，专家组认为投诉人於 2012 年 11 月 8 日在知道投诉人商标的情形下，即"PAUL SMITH"、"  "及"  "注册争议域名。

专家组同意投诉人的见解，认为唯一能解释被投诉人注册争议域名的动机是「利用争议域名销售带有投诉人商标的假冒商品」。有见及此，专家组认为被投诉人注册争议域名的行为，就是蓄意地利用投诉人"PAUL SMITH"、"  "及""等商标的知名度，以获取直接与争议域名相关的利润。

再者，本案的案情跟一案中的案情十分吻合。被投诉人利用争议域名的网站作为一个平台，公然售卖带有投诉人商标的假冒商品（见：http://www.paulsmithensoldes.com），而这与专家组於现案件所作出的判决相应。有见及此，专家组认为被投诉人塑造了一个情形，就是网上的用户极易被误导或混淆被投诉人的网站确实与投诉人有直接或简接的联系。专家组认为这种行为确实难以接受，并且认为此等行为印证了被投诉人注册或使用争议域名的恶意。

被投诉人没有提出任何答辩。

基於 Zurich Insurance Company，Paul Smith Group Holdings Limited 及 Deutsche Telekom AG 的原则及上述之见解，专家组认为被投诉人并没有就使用争议域名上提供任何善意及合理的解释。 综合上述之理由，专家组根据《统一域名争议解决政策之规则》第 4(b)条所述，得出的结论是投诉人对该域名的注册和使用确实具有恶意。

6. 裁决

投诉人提出了有力的证据。投诉人拥有的商品商标，即“PAUL SMITH”、“Paul Smith”及“PS · Paul Smith”与本案争议之域名混淆性地近似。

被投诉人就争议域名不享有权利或合法利益。

被投诉人出於恶意注册并使用争议域名。

综合所述，根据第 4(i)条的规定，专家组决定争议域名转移给投诉人保罗史密斯集团控股有限公司(PAUL SMITH GROUP HOLDINGS LIMITED)。

专家组：陶荣

2013 月 9 月 16 日